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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,571	12/19/2000	Kathryn L. Parker	MS #155647.1/40062.88-US-	5903
7590 Homer L. Knearl Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER PATEL, HARESH N	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 07/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/741,571

Applicant(s)

PARKER ET AL.

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 8-18 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 8-18 and 26-34 is/are rejected.
- 7) ☒ Claim(s) 6, 8 and 26-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 6, 8-18, 26-34 are subject to examination. Claims 1-5, 7, 19-25 are cancelled.

Response to Arguments

2. Applicant's arguments dated 4/26/07 with respect to the claims 6, 8-18 and 26-34 have been considered but are moot in view of the new ground(s) of rejection, necessitated by the applicant's amendment to the claims. (Note: Amended claims 6 and 9 are independent claims. The scope of the claimed subject matter of the amended claims 6 and 9, dated 4/26/07, is narrower as compared to the previously presented claims 6, 7 (now cancelled) and 9, dated 10/13/2006, of the office action 1/8/2007).

Drawings

3. Considering the remarks dated 4/26/2007 regarding the objections of the drawings of the office action dated 1/8/2007, the objections of the drawings is withdrawn.

Claim Objections

4. Amended Claims 6, 8, 26-34 are objected to because of the following informalities:

Amended claim 6 mentions, "storage medium executable by a computer and encoding", which should be --storage medium of a computer encoding-- (Note: storage medium itself cannot be executable by the computer. Claims 8, 26-34 depend upon claim 6 and include limitations of claim 6 and hence are objected).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 6, 8-18 and 26-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Major et al. 7,209,955, Research In Motion Limited (Hereinafter Major-Research-In-Motion).

7. Referring to claim 6, Major-Research-In-Motion discloses **a computer storage medium** (usage of RAM, FLASH memory, etc., col., 14, lines 25 – 35) **executable by a computer** (usage of communication device, software program and storage medium of the device for supporting notifications as per user selections for different notifications, col., 8, lines 22 – 46, col., 10, lines 23 – 43) **and encoding instructions for executing a computer process** (usage of software program notifying events to the user of the communication device, col., 8, lines 22 – 46, col., 10, lines 23 – 43) **for notifying a user of a small computer device of notification events** (usage of software program of the communication device such as hand-held two-way wireless paging computer, palm-top computer, mobile telephone to provide notifications to the user for the user selected notification events, col., 8, lines 22 – 46, col., 10, lines 23 – 43), **the process comprising:**

storing (usage of the storage medium to store notification profiles, col., 8, lines 22 – 46, col., 10, lines 23 – 43) **two notification profiles** (usage of different profiles i.e., calendar

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notification events profile, instant notification events profile, email message events profile, reminder profile, figure 6, col., 10, lines 23 – 43) **for a user** (for a particular user, col., 10, lines 3 – 9), **such that each notification profile is assigned a predetermined notification mode** (usage of predetermined priority levels, regular versus very important and predetermined alert types, audible, visual, vibrate, etc assigned to the notification profiles, figure 6, col., 12, lines 25 - 65) **from a selection of notification mode** (from selected mode such as regular versus very important and audible versus visual or vibrate, figure 6, col., 12, lines 25 - 65) **such that each notification profile has a notification event** (usage of notification events of the profiles for email message, calendar, instant notifications or reminder, figure 6, col., 12, lines 25 – 65, col., 8, lines 50- 56) **and such that each of the notification events** (usage of different email message notifications, different calendar events, different instant notifications, reminder alerts, figure 6, col., 12, lines 25 – 65) **is assigned a notification type from a selection of notification type** (assigning of different events i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and usage of priority ranking, to notify user as per user specified selections, figure 6, col., 12, lines 25 – 65);

displaying (usage of user interface, col., 21, lines 14 – 21) **a notification mode menu** (usage of notification screen with notification selections having sub selections for the user, col., 12, lines 6 – 37);

receiving a selection signal (software program receiving user-selection of the notifications, col., 12, lines 6 – 48) **to select a notification mode** (to select mode being regular versus very important and audible versus visual or vibrate, figure 6, col., 12, lines 25 - 65) **from**

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the displayed notification mode menu (from the notification screen with notification selections having sub selections for the user, col., 12, lines 6 – 37);

applying the selected notification mode (software program applying the user-selection of the notification mode, col., 12, lines 6 – 48, for example, selection of calendar event that is audibly alerted and email message event visually alerted, col., 11, lines 49 - 60) **to the small computer device** (to the communication device such as hand-held two-way wireless paging computer, palm-top computer, mobile telephone to provide notifications to the user for the user selected notification events, col., 8, lines 22 – 46, col., 10, lines 23 – 43), **such that the device remains in the selected notification mode** (the communication device retaining the notification setting, col., 20, lines 25 – 67) **until another notification mode is selected** (until the user selects different notification mode at the user interface for notification, col., 20, lines 25 – 67); **and**

as a result of applying the selected notification mode (as per the software program applying the user-selection of the notification mode, col., 12, lines 6 – 48), **notifying the user of notification events** (notifying the user of the events of the email message, calendar, instant notifications or reminder, figure 6, col., 12, lines 25 – 65) **with assigned notification types in accordance with the notification profile** (using assigned tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and usage of priority ranking, to notify user as per user specified selections, figure 6, col., 12, lines 25 – 65) **assigned to the selected notification mode** (as per the user-selection of the notification mode, col., 12, lines 6 – 48).

Note: Page 19, lines 16 – 21 of the specification of this application under prosecution, clearly states, “Although the invention has been described in language specific to structural

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features and/or methodological steps, it is to be understood that the invention defined in the appended claims is not necessarily limited to the specific features or steps described. Rather, the specific features and steps are disclosed as preferred forms of implementing the claimed invention. Since many embodiments of the invention can be made without departing from the spirit and scope of the invention, the invention resides in the claims hereinafter appended”.

Note: Regarding the applicant's usage of “wherein” and/or “whereby” in the claimed subject matter of the claims, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. Please see *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003). MPEP 2111.

8. Referring to claim 8, Major-Research-In-Motion discloses the claimed limitations rejected under claim 6. Major-Research-In-Motion also discloses the computer device further comprises a **calendar-type application program** (usage of calendar application for calendar notification events, col., 11, lines 48 – 67) **storing reminder events** (calendar events, reminder events, figure 6) **and such that the selection signal for selecting one notification mode** (software program applying the user-selection of the notification mode, col., 12, lines 6 – 48, for example, selection of calendar event that is audibly alerted and email message event visually alerted, col., 11, lines 49 - 60) **is generated by the calendar-type application program** (usage of calendar application for generating calendar notification events, col., 13, lines 4 – 35, col., 10, lines 25 - 44).

9. Referring to claim 9, Major-Research-In-Motion discloses **a computer system for notifying a user of notification events** (usage of communication device, software program and storage medium of the device for supporting notifications as per user selections for different notification events, col., 8, lines 22 – 46, col., 10, lines 23 – 43), **the system comprising:**

a memory unit (usage of RAM, FLASH memory, etc., col., 14, lines 25 – 35) **storing a** (usage of the storage medium to store notification profiles, col., 8, lines 22 – 46, col., 10, lines 23 – 43) **plurality of notification profiles** (usage of different profiles i.e., calendar notification events profile, instant notification events profile, email message events profile, reminder profile, figure 6, col., 10, lines 23 – 43) **for a user** (for a particular user, col., 10, lines 3 – 9), **such that each notification profile is assigned a predetermined notification mode** (usage of predetermined priority levels, regular versus very important and predetermined alert types, audible, visual, vibrate, figure 6, col., 12, lines 25 - 65) **and such that within each notification profile are notification events** (different email message notifications, different calendar events, different instant notifications, reminder alerts, figure 6, col., 12, lines 25 – 65) **such that each of the notification events is assigned a notification type** (different events assigned i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and usage of priority ranking, to notify user as per user specified selections, figure 6, col., 12, lines 25 – 65).

a first output unit (usage of one of the output units, for notifying audible tune 1 or tune 2, verbal 1 or verbal 2; for notifying visual alert; for notifying vibrate alert using vibrate 1 or vibrate 2, figure 6, col., 8, lines 9 – 28) **notifying the user of a first notification event using a first notification type** (notifying user using one of the different events using tune 1 or tune 2 or

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verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and priority ranking, figure 6, col., 12, lines 25 – 65);

a second output unit (usage of another output units, for notifying audible tune 1 or tune 2, verbal 1 or verbal 2; for notifying visual alert; for notifying vibrate alert using vibrate 1 or vibrate 2, figure 6, col., 8, lines 9 – 28) **notifying the user of the first notification event using a second notification type** (notifying user using one of the different events using tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and priority ranking, figure 6, col., 12, lines 25 – 65, col., 11, lines 48 - 67) **such that the second notification type is different from the first notification type** (usage of different notification types, i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and priority ranking, figure 6, col., 12, lines 25 – 65);

a processing unit (usage of processor of the communication device, col., 8, lines 22 – 38) **in response to a profile selected from the plurality of profiles** (one of different profiles i.e., calendar notification events profile, instant notification events profile, email message events profile, reminder profile, figure 6, col., 10, lines 23 – 43) **in the memory unit** (usage of RAM, FLASH memory, etc., col., 14, lines 25 – 35) **in response to the notification event** (notification event for the user), **automatically determining** (without manual intervention determining of which tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2 to use for the event, figure 6, col., 12, lines 25 – 65) **whether to notify the user using the first notification type or the second notification type** (whether to use tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and priority ranking, to notify user as per user specified selections, figure 6, col., 12, lines 25 – 65); **and**

the processing unit (usage of processor of the communication device, col., 8, lines 22 – 38) **utilizing the first or second output unit to notify the user** (utilizing one of the output units for notifying the user using audible alert by tune 1 or tune 2, verbal 1 or verbal 2; or visual alert; or vibrate alert by vibrate 1 or vibrate 2, figure 6, col., 8, lines 9 – 28).

10. Referring to claims 10 and 33, Major-Research-In-Motion discloses the claimed limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses **wherein a type of notification event, the notification event is a reception of email over a wireless network** (usage of wireless network and email message, col., 7, lines 60 – 67, col., 8, lines 50 – 56).

11. Referring to claims 11 and 34, Major-Research-In-Motion discloses the claimed limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses **wherein the notification event is a calendar event stored by a calendar-type application program** (usage of calendar application for supporting calendar notification events, col., 13, lines 4 – 35, col., 10, lines 25 – 44).

12. Referring to claims 12 and 28, Major-Research-In-Motion discloses the claimed limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses **wherein the first notification type is an audible signal** (usage of tune 1 or tune 2 or verbal 1 or verbal 2, figure 6, col., 12, lines 25 – 65) **and the second notification type is a visual display** (usage of visual notification type, figure 6, col., 12, lines 25 – 65).

13. Referring to claims 13 and 29, Major-Research-In-Motion discloses the claimed limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses **wherein the first notification type is a vibration signal** (usage of vibrate 1 or vibrate 2, figure 6, col., 12, lines 25 – 65) **and the second notification type is an audible signal** (usage of tune 1 or tune 2 or verbal 1 or verbal 2, figure 6, col., 12, lines 25 – 65).

14. Referring to claims 14 and 30, Major-Research-In-Motion discloses the claimed limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses **wherein the stored notification profiles include an assignment of a particular sound file to a particular event** (usage of file supporting tune 1 or tune 2 or verbal 1 or verbal 2, figure 6, col., 12, lines 25 – 65, usage of audio files or clips, col., 8, lines 2 - 14).

15. Referring to claims 15 and 31, Major-Research-In-Motion discloses the claimed limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses **wherein each profile comprises an event notification type based on a user's environment** (usage of notification type base on user environment including noise level around the user, col., 14, lines 7 – 24).

16. Referring to claims 16 and 32, Major-Research-In-Motion discloses the claimed limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses **wherein a user capable of being notified of an event in a plurality of ways, depending on a selected**

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profile (usage of different events i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and usage of priority ranking, as per user selected profile i.e., for calendar profile versus email message profile, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 - 65).

17. Referring to claim 17, Major-Research-In-Motion discloses the claimed limitations rejected under claims 9 and 16. Major-Research-In-Motion also discloses **wherein user has a plurality of profiles** (user having calendar profile versus email message profile, instant notification profile, reminder profile, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 - 65).

18. Referring to claim 18, Major-Research-In-Motion discloses the claimed limitations rejected under claims 9, 16 and 17. Major-Research-In-Motion also discloses **wherein each of the plurality of profiles** (user having calendar profile versus email message profile, instant notification profile, reminder profile, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 - 65) **contains a plurality of notifications events** (calendar events, email message events, instant notification events, reminder events, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 - 65) **and assigned notification types** (different assigned i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and usage of priority ranking, to notify user as per user specified selections, figure 6, col., 12, lines 25 - 65).

19. Referring to claim 26, Major-Research-In-Motion discloses the claimed limitations rejected under claim 6. Major-Research-In-Motion also discloses wherein the computer process for notifying a user of a small computer device of notification events further comprises: **selecting**

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a particular notification mode (usage of software program for selecting the notification mode, col., 12, lines 6 – 48, for example, selection of calendar event that is audibly alerted and email message event visually alerted, col., 11, lines 49 - 60) **to modify a notification profile assigned to that mode** (updating of one of the calendar notification events profile, instant notification events profile, email message events profile, reminder profile and priority levels, regular versus very important and predetermined alert types, audible, visual, vibrate, etc., figure 6, col., 10, lines 23 – 43, col., 12, lines 25 - 65); **modifying the notification profile** (updating of the notification profile, figure 6, col., 10, lines 23 – 43, col., 12, lines 25 - 65); **and storing the modified profile** (usage of RAM, FLASH memory, etc., col., 14, lines 25 – 35 to store updated profile, col., 8, lines 22 – 46, col., 10, lines 23 – 43).

20. Referring to claim 27, Major-Research-In-Motion discloses the claimed limitations rejected under claim 6. Major-Research-In-Motion also discloses wherein the computer process for notifying a user of a small computer device of notification events further comprises: **assigning a plurality of volume levels** (usage of adjusting volume level associated with notification, adjusting of volume level of audible signal as per the user environment requirement, col., 14, lines 7 – 34) **of the small computer device** (of the communication device such as hand-held two-way wireless paging computer, palm-top computer, mobile telephone, col., 8, lines 22 – 46, col., 10, lines 23 – 43), **with different notification types assigned to notification events** (using different events assigned with notification types, i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and usage of priority ranking, figure 6, col., 12, lines 25 – 65) **within a notification profile** (of the updated notification profile, figure 6, col., 10, lines 23 – 43, col.,

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12, lines 25 - 65); **and selecting volume levels for different notification types** (adjusting volume level associated with notification depending upon different notification types, adjusting of volume level of audible signal as per the user environment requirement, col., 14, lines 7 - 34) **assigned to notification events within a notification profile** (of the updated notification profile having notification events, figure 6, col., 10, lines 23 - 43, col., 12, lines 25 - 65).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Haresh Patel

Haresh Patel

7/8/07